



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,517	10/24/2003	Bernard J. Patsky	UTL 03-032	9868

7590 03/16/2005  
JAMES F. BAIRD, ESQUIRE  
33 East Main Street  
P.O. Box 574  
West Brookfield, MA 01585-0574

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

621

<b>Office Action Summary</b>	<b>Application No.</b> 10/692,517	<b>Applicant(s)</b> PATSKY, BERNARD J.	
	<b>Examiner</b> Stephen L. Blau	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
     4a) Of the above claim(s) 1,2,6-16 and 18-24 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 3-5 and 17 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The change to claim 5 is agreed with. Claims 4 (line 1) and 17 (line 2) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "may" is indefinite. It is uncertain if the function being referred is required to be performed or not. The examiner recommends replacing the word with the words -- is able to --.

### ***Content of Specification***

3. The change to the title is agreed with.

### ***Specification***

4. The argument and the changes to the disclosure are agreed with and the objections are removed.

5. The new abstract is agreed with.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Jessen and Kobayashi.

Ryan discloses a golf club with a parallax corrected (abstract, Col. 1, Lns. 19-25, 29-35) sweet spot markings, a marking extending from a point at the intersection of the face surface and the top surface (Fig. 5), and a reference line on a drawing showing non-corrected target lines and corrected lines (Figs. 2, 3, 5). Ryan does not disclose have markings on a head for a non-corrected target marking but clearly an artisan skilled in assisting a golfer in aligning a club to a ball would have selected a suitable marking arrangement in which having both the non-corrected marking and a corrected marking as shown by the reference lines in figures 2-3 and 5 is included.

Ryan lacks a grip, sweet spot target line markings, a line extending from a point at the intersection of the face surface and the top surface, lines on a head showing non-corrected target lines and corrected lines, an increased width line on a top surface ending at a point at the intersection of the top surface with the bottom surface and

Art Unit: 3711

center of gravity located behind a sweet spot. Jessen discloses a golf club having a grip (Fig. 2), an alignment marking (Ref. No. 15, Col. 2, Lns. 20-28) being in the form of a broad line on a top surface (Fig. 6) extending from a point at the intersection of the face surface and the top surface and a line on a head showing non-corrected target line (Fig. 6). Kobayashi discloses a head having a top surface intersection in a rear of a head with a bottom surface (Fig. 2) and center of gravity located behind a sweet spot (Col. 2, Lns. 44-53) in order to increase distance of flight of a ball with improved directing performance (Col. 2, Lns. 59-62). In view of the patent of Jessen it would have been obvious to modify the golf club of Ryan to have a grip in order to minimize the vibrations felt by a player. In view of the patent of Jessen it would have been obvious to modify the golf club of Ryan to have increased width lines on a top surface ending at a back end of a top surface showing a corrected target line in order to utilize a parallax corrected line instead of an arrow marking to assist a player in properly aiming a head who prefers a line while playing a round of golf. In view of the patent of Kobayashi it would have been obvious to modify the head of Ryan to have a top surface intersect with a bottom surface in order to use the advantages of parallax correction for an alignment of a club for a head which has a bottom surface which intersects with a top surface at a rear end. As such a line on a top surface would end at a point at the intersection of the top surface with the bottom surface. In view of the patent of Kobayashi it would have been obvious to modify the head of Ryan to have a center of gravity located behind a sweet spot in order to increase distance of flight of a ball with improved directing performance.

It would have been obvious to modify head of Ryan to have both lines on a head showing a non-corrected target line and a corrected line in order to assist a player in showing a player or a golf manufacturing company how severe a ball is misaligned from a sweet spot by not having a parallax correction alignment marking and the need to have a parallax corrected alignment.

With respect to claims 4-5 and 17, very little weight is given to the method steps of how the parallax corrected target line is made on the head since this is an apparatus claim and not a method claim. Weight is given to what an apparatus is and not how it is made. The club due to the combination of Ryan in view of Jessen and Kobayashi is the same product as that claimed in claims 4-5 and 17.

### ***Response to Arguments***

8. The argument that Ryan does not show lines that appear on the golf club and are only drawing lines is agreed with. As such the examiner has modified the rejection and has not made this Office Action final. However based on the reference lines shown on the drawings by Ryan, the examiner believes it would be obvious to one skilled in the art to show these drawing reference lines as actual lines on a golf club since it is practiced to have lines on a golf club. The argument that it is improper to use the reference of Ryan due to the corrected target marking compensating for dynamic conditions (shaft bow) and static conditions (sight error) is disagreed with. Not all golfers have strengths which result in a shaft bowing during the swing or not all golfers choose to swing a club

Art Unit: 3711

at a force to produce bowing. It would be obvious to correct only for static conditions to one skilled in the art. The argument that it is improper to use Jessen since Jessen does not consider bowing or parallax is disagreed with. Jessen was not used to show an alignment marking being corrected but that it is known to have lines as alignment markings. Ryan was used to show corrected alignment markings. The argument that the reference of Kobayashi is improper due to Kobayashi never using terms of top surface and bottom surface is disagreed with. Though Kobayashi does not mention these terms clearly figure 2 shows a top surface intersecting with a bottom surface. There is no intermediate surface between these surfaces.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 13 March 2005



**STEPHEN BLAU**  
**PRIMARY EXAMINER**